

## **REMARKS**

### **I. Introduction**

Applicant thanks the Examiner, Benjamin Layno, for the courtesies extended to Applicant's representative, Andrew Reibman, Esq., during the telephonic interview of March 30, 2006. Claims 1, 3, 4, 7, 14, 16, 17, 18, 19, 22, 30, 31, 32, 33, 36, 38, 39, and 41 were discussed. Applicant's representative gave an overview of the invention, and then identified various features of the above claims which Applicant believes are not contained in the cited Goldberg reference. Applicant's positions are summarized in the remarks given below. No other references were discussed. Although no agreement was reached, the Examiner indicated he would further consider the Applicant's arguments upon receipt of this paper.

Claims 1-23 and 30-41 stand rejected. Claims 24-29 were previously cancelled. Claims 30, 31, 32, and 33 have been amended. Claim 30 and 31 has been amended only in the preamble. Claims 32 and 33 has been amended to correct an antecedent basis problem – both claims already recited “the instant win lottery ticket” without providing an antecedent basis. Accordingly, although the amendment makes the claim language clearer, and conforms the claims to patent office practice, no new claim limitation has been added by the amendment. Thus, Applicant respectfully submits that the amendment advances the prosecution by placing the claims in better form for appeal, without requiring a new search. Accordingly, Applicant respectfully requests that Examiner enter the amendment. No new matter was added by the amendment, which is supported by the original disclosure.

Reconsideration of all pending claims and entry of the amendment is respectfully requested, in light of the arguments given below.

### **II. Rejection of claims 1-23 and 30-41 under 35 U.S.C. 102(b)**

Claims 1-23 and 30-41 stand rejected under 35 U.S.C. 102(b) over the Goldberg (U.S. Patent 5,374,060).

Goldberg is generally directed to a horse racing bet slip (Figure 4), which allows a user to select entries in each of a series of races. The bet slip is tendered, and the player receives a receipt (Fig. 6) which includes the player's selections and a field giving the sum of the entry numbers of the player's original selections on the bet slip (Element 65 in Fig. 6).

Applicant's amended claim 1 recites:

A method of playing a game of chance, comprising:

receiving an initial ticket including initial game play information and a unique initial ticket identifier;

submitting the unique initial ticket identifier as part of a request to purchase additional game play information not found on the initial ticket;

receiving additional game play information not found on the initial ticket when the initial ticket was received, the additional game play information associated with the unique initial ticket identifier; and

determining if a player is a winner based upon a combination of the initial game play information and the additional game play information.

Applicant respectfully claims that this claim is neither taught nor suggested by the cited Goldberg reference.

The Examiner does not identify where Goldberg allegedly teaches that “the additional game play information” is “associated with the unique initial ticket identifier”. The Examiner cites element 65 of Goldberg Fig. 6 as allegedly being the “additional game play information” recited in Applicant’s claim 1. The Examiner cites element 45 of Goldberg Fig. 4 as allegedly being the “unique initial ticket identifier”. Applicant notes that there is nothing either taught or suggested in Goldberg that associates Goldberg’s element 65 and Goldberg’s element 45. Goldberg’s code 45 is not found on the receipt of Goldberg’s Fig. 6 where Goldberg’s element 65 is located. Nothing in the specification of Goldberg says that the code 45 and 65 are associated in any way. In fact, the only mention of Goldberg’s code 45 in Goldberg’s specification is at 3:28-29. Moreover, two players making identical wagers would receive identical versions of Goldberg’s Fig. 6 receipt – nothing making this receipt unique is mentioned by Goldberg. To anticipate a claim, the reference must teach every element of the claim. *See* MPEP 2131. The identical invention must be shown in as complete detail as is contained in the .. Claim. *See id.* (citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989)). Here the recited association between the unique initial ticket identifier and the additional game play information is entirely absent from the cited Goldberg reference. For at least this reason, Applicant submits that claim 1 is not anticipated by Goldberg.

The Examiner also does not indicate how a winner is based on “a combination” of the initial game play information” and the “additional game play information” While a player can win in Goldberg based on the individual race selections, and also based on the sum of the race selections – these are two separate and independent ways of determining a winner in each of two separate games. There is nothing in Goldberg describing or teaching determining if a player is a winner based on a combination of the initial game play information and the additional game play information. Applicant submits that Goldberg does not anticipate claim 1 for at least this additional reason.

Claims 2-6 ultimately depend from claim 1, and thus should be allowable for at least the same reasons as claim 1.

Separately and independently, claim 3 recites that “the additional game play information is provided on the initial ticket”. The Examiner has not identified this feature in Goldberg. Applicant respectfully submits that it is not present; in particular the element 65 which the Examiner alleges is the “additional game play information” in Goldberg, is found *only* on Goldberg’s Figure 6 receipt card – the second card which the player receives, not the initial one. Accordingly, claim 3 is not anticipated by Goldberg for at least this additional reason.

Claim 4 recites “receiving a prize if an authentication code on the winning ticket is validated”. The Examiner cites Goldberg 3:42-45 as allegedly teaching this feature. However, this code is found only on Goldberg’s first card, not the Figure 6 card which is redeemed for a prize in Goldberg’s game. Accordingly, claim 4 is not anticipated by Goldberg for at least this additional reason.

Claim 6 recites “determining whether the initial ticket is a winning ticket”. Goldberg’s first card, which the Examiner cites as the initial ticket, is a pick slip and can not be a winning ticket in Goldberg’s game. Accordingly, Goldberg does not teach or suggest this limitation of claim 6. Claim 6 thus should be allowable for at least this additional reason.

Claim 7 recites “providing additional game play information associated with the unique initial ticket identifier”. As discussed above for claim 1, this limitation is neither taught nor suggested by Goldberg. Goldberg also does not teach that whether a player is a winner is determined based on “a combination” of the initial and additional game play information. For at least these reasons, Claim 7 thus is not anticipated by Goldberg.

Claims 8-18 depend ultimately from claim 7, and thus should be allowable for at least the same reasons as claim 7.

Claim 9 recites that the additional game play information is provided “on the initial ticket”. The only thing alleged by the Examiner to be “additional game play information” in Goldberg is element 65, which is found only on the second card. Accordingly, Goldberg neither teaches nor suggests additional game play information being provided “on the initial ticket”. Applicant respectfully requests claim 9 should be allowed for at least this additional reason.

Claim 12 recites a ticket log. The Examiner has not identified this feature in Goldberg. Applicant respectfully submits that this feature is not taught or suggested by Goldberg. Claim 12 thus should be allowable for at least this additional reason.

Claim 16 recites that “the generating of the additional game play information is based in part on a random selection”. In Goldberg, the element 65, which the Examiner alleges is the “additional game play information”, is the sum of the player’s race selections on the first card. No other method of generating element 65 is described by Goldberg. Thus, no random process is used in generating element 65. Accordingly, Applicant submits that this claim is not anticipated by Goldberg for at least this additional reason.

Claim 17 recites that a game outcome is determined, and *after* that determining, additional game play information is generated so that the correct outcome is reflected. This feature is neither taught nor suggested by Goldberg. Thus, claim 17 should be allowable over Goldberg for at least this additional reason.

Claim 18 recites choosing a random entry in the prize pool. Applicant submits that a horse race win, place, or show result, does not meet this limitation. Thus, claim 18 should be allowable over Goldberg for at least this additional reason.

Independent claim 19 recites that additional game play information is determined *after* determining the game outcome. As discussed above for claim 17, this feature is not taught or suggested by Goldberg. For at least this reason, claim 19 should be allowable over Goldberg.

Claims 20-23 depend from claim 19 and thus should be allowable for at least the same reason as claim 19.

Claim 22 recites ‘scanning a second chance code on the initial ticket’. The Examiner has not identified this feature in Goldberg. Claim 22, should thus be allowable for at least this additional reason.

Claim 31 recites that additional game play information is determined *after* determining the game outcome. As was discussed above, this feature is absent from

Goldberg. For at least this reason Goldberg does not anticipate claim 31. Claim 31 depends from claim 31 and thus should be allowable for at least the same reason.

Claim 32 depends from claim 1 and thus should be allowable for at least the reasons given above for claim 1. Moreover, claim 32 recites “revealing the initial game play information by removing a scratch-off coating”, a feature neither taught nor suggested by Goldberg’s horse racing game. Claim 32 should thus be allowable for at least this additional reason.

Claim 33 depends from claim 1 and thus should be allowable for at least the reasons given above for claim 1. Moreover, claim 33 recites “redeeming the initial instant win lottery ticket for a prize”. As there is *no* instant win lottery ticket in Goldberg, Goldberg cannot anticipate claim 33 for at least this additional reason.

Claims 34-35 depend ultimately from claim 1 and thus should be allowable for at least the same reasons as claim 1. Moreover, claim 36 expressly recites that the second ticket includes the unique initial ticket identifier. Goldberg’s Figure 6 card, which the Examiner alleges is “the second ticket” does not contain element 45, which the Examiner alleges is Goldberg’s “identifier”. Accordingly, Goldberg can not anticipate claim 36 for at least this additional reason.

Claim 37 recites that the winning is based upon “a combination” of the initial game play information and the additional game play information. As discussed above for claim 1, this feature is absent from Goldberg.

Claim 38 depends from claim 4, and thus should be allowable for the same reasons. Moreover, claim 38 recites that the winning ticket is tendered *without* the additional information but where a prize is determined based on a combination *that includes* that information. This feature is neither taught nor suggested by Goldberg. Thus claim 38 should be allowable for at least this additional reason.

Independent claim 39 recites in part that additional game play information is provided *after* determining an additional game play outcome. This feature is neither taught nor suggested by Goldberg. Accordingly, Goldberg cannot anticipate claim 39.

Claims 40 and 41 depend from claim 39. Accordingly, they should be allowable over Goldberg for at least the same reason as claim 39. Moreover, claim 41 recites that the *initial ticket* is redeemed for a prize based on the additional game outcome, even though the second ticket includes the additional game play information. This feature is neither taught nor suggested by Goldberg.

Accordingly, withdrawal of the section 102 rejection over Goldberg is respectfully requested for all of claims 1-23 and 30-41.

**III. Rejection of claims 30 and 31 under 35 U.S.C. 112**

Applicant submits that the rejection of claims 30 and 31 under 35 U.S.C. 112 is moot in light of the amendment submitted with this paper. In particular, Applicant respectfully submits that both claims 30 and 31 are directed to the statutory class of articles of manufacture, and that this should be clear from the amended claim preambles.

**VI. Conclusion**

In light of the foregoing, it is respectfully submitted that all of the presently pending claims are in condition for allowance. Entry of the amendment, and prompt reconsideration and allowance of the present application are therefore earnestly solicited. The Examiner is invited to telephone Applicant's undersigned representative if any question arises concerning the present application.

Respectfully submitted,

KENYON & KENYON LLP

Dated: April 7, 2006

By:



Andrew L. Reibman  
Reg. No. 47,893

KENYON & KENYON LLP  
One Broadway  
New York, New York 10004  
(212) 425-7200  
**CUSTOMER NO 26646**